

REMARKS

In the present Amendment, claim 1 has been amended to incorporate the subject matter of claim 8. Claims 7 and 8 have been cancelled accordingly. Claims 9, 11, 13 and 17 have been amended consistent to the amendment to claim 1. No new matter has been added, and entry of the Amendment to place the present application in condition for allowance is respectfully requested.

Upon entry of the Amendment, claims 1-5, 9-14 and 17-21 will be pending.

In paragraph No. 1 of the Action, Claims 1-5, 7-14 and 17-21 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakagawa (JP 2000-129037, English translation provided) in view of Nakamura et al (US 6 414 073, "Nakamura").

In paragraph No. 2 of the Action, Claims 1-5, 7-14 and 17-21 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nakagawa in view of Sasaka et al (US 6 186 204, "Sasaka").

Applicants submit that the above two rejections should be withdrawn because Nakagawa, Nakamura and Sasaka do not disclose or render obvious the present invention, either alone or in combination.

Nakagawa is relied upon as teaching a rubber composition for tires comprising copolymer (A) and copolymer (B) as recited in present Claim 1 (abstract).

Nakamura is cited as teaching a pressure sensitive rubber adhesive further comprising a tackifier such as terpene-phenol resin (col. 4, lines 24-34).

Sasaka is cited as disclosing a rubber composition for tire tread comprising a rubber component (mainly SBR), a softener and a specified vulcanization accelerator (abstract and col.

2, lines 2-33) and that the softener may be phenol-terpene resins or petroleum hydrocarbon resins (col. 9, lines 3-6).

However, Nakamura and Sasaka do not disclose any modified C₉-based petroleum resins as recited in present claim 1 as amended. Accordingly, even if a resin disclosed in Nakamura or Sasaka is incorporated into the rubber composition of Nakagawa, a rubber composition of the present invention cannot be obtained.

Further, the matrix copolymer component (A) of Nakagawa is a styrene-butadiene copolymer, while the matrix polymer component (A) of Nakamura is a combination of natural rubber and a styrene-isoprene-styrene block copolymer (abstract). The matrix polymers between Nakagawa and Nakamura are so different from each other that the resins described in Nakamura cannot be easily introduced in the rubber compositions of Nakagawa by those having ordinary skill in the art.

Sasaka is silent about (B) a hydrogenated styrene-butadiene copolymer (b) and Sasaka focuses on road gripping property on wet roads and is silent on road gripping property on dry roads. Therefore, the resins disclosed in Sasaka cannot be easily introduced in the rubber compositions of Nakagawa by those having ordinary skill in the art.

Still further, in the Amendment filed May 9, 2008, Applicants explained that the present invention provides unexpectedly superior results, as shown by the data in Tables 1 and 2, and that none of Nakagawa, Nakamura and Sasaka teach or suggest the unexpectedly superior results provided by the present invention.

In response, the Examiner states:

Regarding Tables 1 and 2, the data is not sufficient to show unexpected results for the inclusion of a tackifier because there is

no comparative example of just Resin A and Resin B. Applicant has multiple examples of Resin A, Resin B and various Resin C's, and also examples of just Resin A, however *without an example of just Resin A and Resin B the Examiner is unable to ascertain whether the results are unexpected.* The Examiner notes that the Example which does contain only Resin A and Resin B further includes a aromatic oil filler additive which is not standard in the other resin compositions. As such the Tables are not convincing and the rejection stands.

Applicants believe that Resin A and Resin B refer to (A) copolymer and (B) copolymer, respectively. Applicants note that (A) copolymer and (B) copolymer are not (C) resins.

In order to demonstrate the unexpectedly superior results provided by the present invention and the patentability of the present invention over Nakagawa, Nakamura and Sasaka, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.132, executed by Mr. Seiichi Kato. Applicants respectfully request that the Declaration be entered and considered because it responds to issues raised by the Examiner and could not have been presented earlier since those issues were first raised in the present Office Action.

In his Declaration, Mr. Kato prepared Comparative Examples A to J which do not contain Aromatic oil. Comparative Examples A and B contain only (A) copolymer and (B) copolymer. Comparative Examples C to J contain (A) copolymer, (B) copolymer and a Resin disclosed in Nakamura or Sasaka as Component (C) as shown in the Tables at page 3 of the specification.

The results of Comparative Example A are shown with those of Examples 1 to 9 and Comparative Examples 1 and 2 in Table 1-1 at page 4 of the Declaration. The results of

Comparative Examples B to J are shown with those of Examples 25 to 29 and Comparative Example 13 in Table 4 at page 6 of the Declaration.

As shown in Table 1-1 at page 4 of the Declaration, in comparison to Examples 6 and 7 which employed C₉-based aromatic resins as component (C), Comparative Example A which contains only (A) and (B) copolymers, but no component (C) or Aromatic oil, exhibited inferior hysteresis loss, inferior dry gripping property and inferior wet gripping property.

As shown in Table 4 at page 6 of the Declaration, in comparison to Examples 25-29 which employed petroleum resins as component (C), Comparative Example B which contains only (A) and (B) copolymers, but no component (C) or Aromatic oil, exhibited inferior hysteresis loss, inferior dry gripping property and inferior wet gripping property.

Also shown in Table 4 at page 6 of the Declaration, in comparison to Examples 25-29 which employed petroleum resins as component (C), Comparative Examples C-J which employed a resin disclosed in Nakamura or Sasaka as Component (C) exhibited, overall, inferior hysteresis loss, inferior dry gripping property and inferior wet gripping property.

That is, the Declaration shows that modified C₉-based petroleum resins employed in the present invention provided unexpectedly superior results in comparison to the resins disclosed in Nakamura and Sasaka.

In view of the above, reconsideration and withdrawal of the §103(a) rejections based on Nakagawa in view of Nakamura and Nakagawa in view of Sasaka are respectfully requested.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
Application No.: 10/518,629

Attorney Docket No.: Q85397

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Hui C. Wauters

Hui C. Wauters
Registration No. 57,426

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: October 14, 2008